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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,468	06/25/2003	Manuel Munoz Saiz	43068-0027	3257

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EXAMINER

SUHOL, DMITRY

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/603,468

Applicant(s)

SAIZ, MANUEL MUNOZ

Examiner

Dmitry Suhol

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10/29/2003.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-12, due to applicants use of the wording “channels, openings orifices” the metes and bounds of the claims can’t be determined. It is not clear if the above features are all the same structure or different structures (i.e. claim 1 uses terminology “peripheral channels or openings” in which case it would appear that applicants are claiming one or the other, however claim 5 appears to imply that they are the same structure).

Regarding claim 2, the structural features encompassed by the phrase “through orifices parallel to tangents to said golf ball” can’t be determined. The locational relationship of the “through orifices” as related to the golf ball is not understood. Since a golf ball is a curved body it may have an infinite number of tangents, therefore it is not clear how the orifice can be parallel to all of them.

Regarding claim 3, the structural features encompassed by the phrase “a series of diametric holes, including several holes parallel to said diametric holes” can’t be determined. The parallel relationship claimed by the applicants is not understood, if

there are a series of holes diametrically placed it is not understood what would constitute a parallel hole to the diametric holes.

Regarding claim 10, the structural features encompassed by the phrase "said openings cross over and inter-communicate on different planes" can't be determined. It is not clear what is being "crossed over", for purposes of examination it is assumed that the openings cross over different planes.

The remainder of the office action considers the claims as best understood.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Peabody '219. Peabody discloses a golf ball containing all of the elements of the claims including, a sphere (51) with openings (figure 2) for providing improved aerodynamics (col. 4, lines 9-11) as required by claim 1. A golf ball incorporating through orifices parallel to tangents to said golf ball, as required by claim 2, is shown in figure 2. A series of diametric holes including several holes parallel to the diametric holes, as required by claim 3, are shown in figure 2. A cross-section of the openings being circular, as required by claims 4-5 and 11, is shown in figure 2.

Claims 1 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Farrar '210. Farrar discloses a golf ball containing all of the elements of the claims, including equally spaced peripheral channels (figure 1, grooves 11) for providing improved aerodynamics (page 3, col. 1, lines 12-16) as required by claim 1. The openings crossing different planes and intercommunicating on different planes, as required by claim 10 is shown in figure 1, where the openings (assumed in this case to be channels) lay on different parallel planes but cross over a number of other (perpendicular planes to the channels/openings).

Claims 1, 5-7, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Hwang '245. Hwang discloses a golf ball containing all of the elements of the claims including, peripheral channels (channels X) spaced at predetermined distances for providing improved aerodynamics (col. 4, lines 26-28) as required by claim 1. The openings crossing different planes and intercommunicating on different planes, as required by claim 10 is shown in figure 1, where the openings (assumed in this case to be channels) lay on different parallel planes but cross over a number of other (perpendicular planes to the channels/openings). Channels/openings having a circular cross-section, as required by claim 5, is shown in figure 15 as element X3. A golf ball surface including dimples, as required by claim 6, is shown in figure 1. Channels/openings having a rectangular cross-section, as required by claim 7, is shown in figure 15 as element X1. The openings crossing different planes and

intercommunicating on different planes, as required by claim 10 is shown in figure 1, where the openings (assumed in this case to be channels) lay on different parallel planes but cross over a number of other (perpendicular planes to the channels/openings).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hwang '245 in view of Peabody '219. Hwang fails to teach through orifices parallel to tangents to a golf ball. Peabody clearly teaches that it is known to provide golf balls with circular (as required by claim 11) through orifices for the purpose of increased aerodynamics (col. 2, lines 29-31). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, to provide the golf ball of Hwang with through orifices for the purpose of improved aerodynamics.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hwang '245 in view of Antonious '265. Hwang fails to explicitly teach that the channels of his invention have trapezoidal cross section. However, Antonious discloses a golf device,

which teaches that it is known to provide channels of a trapezoidal cross-section (fig. 4-5). Therefore it would have been obvious to manufacture the golf ball of Hwang with channels having a trapezoidal cross-section with a larger opening facing outward for the purpose of reducing aerodynamic drag.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hwang '245 in view of Peabody '219 and Antonious '265. Hwang, as modified by Peabody, discloses most of the elements of the claims, as stated above, but for explicitly teaching that the channels of his invention have trapezoidal cross section. However, Antonious discloses a golf device, which teaches that it is known to provide channels of a trapezoidal cross-section (fig. 4-5). Therefore it would have been obvious to manufacture the golf ball of Hwang with channels having a trapezoidal cross-section with a smaller opening facing outward for the purpose of reducing aerodynamic drag.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peabody '219 in view of Eaton '165. Peabody fails to teach that the through orifices of his ball are rectangular as required by claim 12. However, Eaton teaches that it is known to provide a golf ball with rectangular through orifices (figure 1). Therefore it would have been obvious to manufacture the golf ball of Peabody with rectangular through orifices for the purpose of not detracting from the rotundity of the ball.

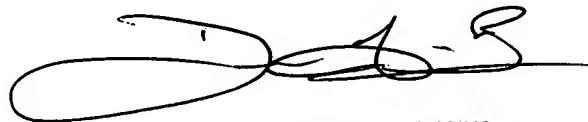
It should be noted that the specific cross-sectional shapes of the channel/openings/through holes, as required by claims 4-5, 7-9, 11-12, are considered to be an obvious choice of design in that the applicants disclose no advantage or critical need for any specific shapes (see applicants specification page 2, lines 12-14).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



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